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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,229	07/18/2003	Joseph F. Bringley	86583PAL	4664

7590 11/07/2005

Paul A. Leipold
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER	
SCHWARTZ, PAMELA R	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,229	BRINGLEY ET AL.	
	Examiner	Art Unit	
	Pamela R. Schwartz	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 3-6, 10, 12-21, 25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-6, 10, 12-21, 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Since both a support and a binder are required to form an image receiving element in accordance with applicants' invention (see page 9), by reciting an image receiving element it is assumed that applicants' are inherently reciting that these required elements of their invention are present.

2. Claims 1, 3-6, 10 and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darsillo et al. (6,365,264) for reasons of record and for reasons set forth below.

3. Claims 1, 3-6, 10, 12-21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darsillo et al. (6,365,264) in view of Bi et al. (2004/0197498) and Alexander et al. (3,007,878) for reasons of record and for reasons set forth below.

4. Applicant's arguments filed August 29, 2005 have been fully considered but they are not persuasive. The rejection under 35 USC 102 has been overcome. With respect to the rejection over Darsillo et al., applicants' arguments are not persuasive for the following reasons. Applicants argue that the reference does not disclosesthe porosity and the gloss as recited by amended claim 1. This is not persuasive because while not disclosing gloss in the terms set forth by applicants, the reference does disclose the importance of gloss and measures the 75° specular gloss in lieu of the 60° gloss recited by applicants. This is a difference in measurement technique. The reference has identified the property, its desirability, and how to measure the property. Thus it would have been obvious to one of ordinary skill in the art to optimize this property in accordance with the reference. With respect to porosity, the reference also discusses this property and the importance of this property. Measurement of the property is

discussed at col. 5, line 60 to col. 6, line 22. Once again, from this disclosure, it would have been obvious to one of ordinary skill in the art to determine and control porosity of the layers in order to allow the desired degree of ink absorption. Next, applicants argue that the reference does not disclose core shell particles. Applicants argue that in order for a particle to be core shell, the surface ahs to be chemically modified with a distinct composition from the core. This is clearly described by the reference at col. 5, lines 1-10. The reference specifically uses the term "surface modification" to describe this process. The importance of properties such as porosity, gloss and fade resistance are all well known to one of ordinary skill in the art. Contrary to applicants' arguments, when the reference states that "it is sometimes preferred" it is stating a preference for cationic particles. The reference discloses both inherently cationic particles and particles that become so through surface modification with a distinct composition, i.e. core/shell particles.

With respect to image fade resistance, contrary to applicants' assertions, there is no definition in the specification that limits the term to issues of light-fastness and oxidative resistance. In addition, inclusion of cationic materials in ink receptive layers does reduce image fade. Cationic agents fix anionic dyes by adsorption making the dyes less likely to react with undesirable oxidative species. This makes the material fade resistant as well as preventing bleeding in the medium. Since applicants do not have a limiting definition of image fade in their specification, they must rely on the more generic use of the term known in the art.

The examiner has also reconsidered Table 1 in view of applicants' claim amendments. The results are not persuasive because there are too many variables changed in these showings. Not only is there a difference in whether or not the particles have a shell, but adding the shell also changes the particle diameters of both the small particles and the large particles. Changes in results cannot be attributed to the shell because two other values are varied at the same time, i.e. the size of the small particles and size of the large particles. Of course, by changing the particle sizes, the particles will be packed differently and changes in absorption and gloss can no longer be attributed to whether or not the particles have a shell. Therefore, applicants' statement that "for the inventive examples wherein the particles are shelled with a material providing image fade resistance, surprisingly, gloss increases upon introduction of larger particles, and concurrent, high-porosity, high-gloss and low-fade are achieved only over the inventive region, having a surprisingly high-fraction of large particles" has not been supported by showings. In order for the showings to demonstrate the results that applicants intend for them to demonstrate, the shelled and unshelled particles used in the examples should be the same size.

Next, applicants argue that the gloss of the reference is "poor" unless the medium is calendared. It is unclear why applicants consider the levels of gloss disclosed by the reference to be poor. Applicants claim gloss levels as low as 15, however, the reference level of 17.2 is considered by applicants to be poor. Clarification is requested concerning this argument.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
November 3, 2005